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JAMES D HALSEY JR
STAAS & HALSEY
700 ELEVENTH STREET NW
SUITE 500
WASHINGTON DC 20001

EXAMINER

TRANSMISSION

ART UNIT

PAPER NUMBER

2163
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/187,749

Applicant(s)
Utsumi et al.

Examiner
M. Irshadullah

Group Art Unit
2163



☒ Responsive to communication(s) filed on Aug 3, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This communication is in response to the amendments filed August 30, 2000.

Summary Of Instant Office Action

2. Applicant's arguments, filed August 30, 2000, concerning claims 1-7 rejections, para 4, Office Action, Paper No. 4, mailed April 26, 2000 have been considered, deemed unpersuasive and are maintained.

3. Applicant's amendments to specification as per Examiner's suggestion are duly acknowledged, appreciated and entered.

4. Newly added claim 8 has been entered and is prosecuted in the response set out below.

Claim Objections

5. Claims 1 and 8 are objected to because of the following informalities:

A) Claims 1 and 8: " decoding means " and " decoding ", ought to be "decrypting means" and "decrypting" respectively.

B) Claim 8: a comma (,) is wanting between "media ID" and "the key".

Appropriate corrections are appreciably required for the benefit of the Patent Community.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 103(b) as being unpatentable over Ross et al (US Patent 5,553,139) in view of Hasebe et al (US Patent 5,392,351).

Ross et al disclose:

Claim 1. A license devolution apparatus [Title and col 1, lines 7-8] accessing a first storage medium storing contents encrypted with a predetermined key [Col 1, line 57, recited with lines 52-53, Fig. 6B described col 1, lines 46-51, Fig. 5 (Enabler Keys), Fig. 2 (210, 216, 218) recited with col 6, lines 1-3, 8-13, 16 and 19-20. It needs be mentioned that the use of a predetermined (enabler) key or a key generated during encryption process are notoriously known in the art under discussion], and a first encryption secure information generated by encrypting the key and a first use information, representing a right to use the contents, together with one another or individually, with the first media ID, and accessing a second storage medium, wherein the right of using the contents stored in said first storage medium is devolved from said first storage medium to said second storage medium [Col 6, line 49, col 1, lines 51-54 read with lines

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37-38 (application/content of first media/CD and by the same token another application program/content relating to second media/diskette), and col 6, lines 40-49 together with lines 52-54], yet

Ross et al do not show:

- a first media ID, identifying the first storage medium,
- (storing) a second media ID identifying the second storage media.

However, Hasebe et al teach the same [Fig. 2 (12) described col 2, lines 9-12, col 9, lines 1-9].

It would have been obvious to one of ordinary skill in the license/information protection/securing art at the time of applicant's invention to include media IDs in Ross et al's invention, because it would provide additional/enhanced protection to electronic data/information in addition to copyright protection.

said license devolution apparatus comprising:

- a) decoding means for decoding the first encryption secure information stored in said first storage medium using the first media ID to obtain the key and the first use information [Ross et al: Col 4, lines 22-24, col 6, lines 40-59 (specifically line 49, 52-56), col 7, lines 28-40, 47-55, Fig 4 described col 7, lines 56-65 continue col 8, lines 5-8, and Fig. 7 (C, D, E), and discussion about media ID above]; and

- b) encryption means for encrypting with the second media ID, the key and a second use information, representing a second right to use the contents from the first storage medium to the

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second storage medium together with one another or individually with the second media ID, to generate a second encryption secure information for storage in said second storage medium [Ross et al: Fig 2 (210, 218), Fig. 5 (A, B), col 3, lines 17-24, col 6, lines 40-49 and 51-52 recited with col 4, lines 8-15, col 3, lines 34-45 and col 7, lines 32-55, and discussion about media ID above].

Claim 2. A license devolution apparatus according to claim 1, wherein said encryption means encrypts with the first media ID a third use information, obtained through subtracting the second use information from the first use information, or encrypts with the first media ID both the key and the third right of using, to generate a third secure information and stores the third encryption secure key in the first storage medium [Ross et al: Fig. 2 (210, 218), Fig 5 (A, B), Fig. 5 (any of 2-4 would be considered as third user of the third right of using and obtained by eliminating/subtracting the second right of using from the first right of using) and col 3, lines 40-45, and discussion about media ID above].

Claim 3. A license devolution apparatus according to claim 1, wherein if the entire rights of using the contents, to which the first storage medium is entitled, are devolved to the second storage medium [Claim 1, lines 37-41, col 4, lines 8-15 and col 6-col 7(upto line 20)].

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Claim 4. A license devolution apparatus according to claim 1, wherein before devolution of the right to use the contents, the first storage medium stores contents whose right to use is intended to be devolved as encrypted contents [Figs. 6A and 6B described col 1, lines 31-61], and

wherein said license devolution apparatus further comprises contents transfer means for reading the encrypted contents from the first storage medium, and storing in the second storage medium the read encrypted contents [Claim 1, lines 37-41. Reading devices, like diskette or CD drives are inherently implied].

Claim 5. A license devolution apparatus according to claim 1, wherein the first use information and the second use information represent the presence of the right to use, and the third use information represents the absence of the right to use [Fig. 7, any of 2-4 would be a first (user) of first use information, a second (user) of second use of information and when two are using the use information, third one (say, installer) would be unable/absent to have the right of using the use information unless the use information is transferred/distributed/devolved simultaneously to all].

Claim 6. A license devolution apparatus according to claim 1, wherein the first use information represents of a first available number of times or available time, the second use information is represents a second available number of times or available time which is less than

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the first available number of times or available time, and the third use information represents a third available number of times or available time which is obtained through subtracting the second available number of times or available time from the first available number of times or available time [Inherently implied, since the user under the agreement would be obliged to use the product (document, picture or program) for certain number of time(s) and when one user would transfer/devolve the right of use, he could only do so for the remainder of one's available number of times].

Claim 7. A license devolution apparatus according to claim 1, further comprising a first drive and a second drive driving the first storage medium and the second storage medium, respectively, said first drive and said second drive having a first firmware and a second firmware accessing the first storage medium and the second storage medium, respectively [Inherently implied; the diskette or CD or other media drives have their respective drivers or softwares/firmwares for running the same],

wherein said decoding means and said encryption means are arranged in a firmware consisting of said first firmware and said second firmware in form of a composite unit; and wherein only said first firmware has authority to access the first storage medium driven by said first drive, and only said second firmware has authority to access the second storage medium driven by said second drive [Inherently implied; each driver (software/firmware) would be able (have authority) to run its respective media having an ID and access the information on it].

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In the following claim Ross et al show: “ a predetermined key [Fig. 5 (Enabler Key)]”, and do not explicitly show “ storing in storage media ”.

Claim 8. A license devolution method, comprising:

However, Hasebe et al teach the following except above mentioned “ predetermined key ”:

a) storing in a first storage medium contents encrypted with a predetermined key, a first media ID identifying the first storage medium, and encryption secure information generated by encrypting with the first media ID, the key and a first use information, which represents a right to use the contents [Fig. 4 (s3, s6, s7) described col 6, lines 3-43, Fig. 2 (12, 13, 14), col 4, lines 10-15. Col 5, lines 3-7].

“Storing” in computer art is notoriously known. It would have been obvious to one of ordinary skill in the art at time of instant invention to use the available technique/procedure.

Following steps are method steps of apparatus claim above, same rationale applies as to elements claim 1(a) and 1 (b) above.

b) decoding the first encryption secure information using the first media ID to obtain the key and first use information;

c) generating a second encryption secure information by encrypting with a second media ID, which identifies a second storage medium, the key and second use information, which represents a second right to use the contents that is devolved from the first storage medium to the second storage medium; and

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storing the second encryption secure information in said second storage medium, wherein the right to use the contents stored in the first storage medium is devolved from the first storage medium to the second storage medium [Hasebe et al: Fig. 4 (s3, s6, s7), col 6, lines 3-43 read with col 4, lines 62-64, col 9, lines 6-9].

Response to Arguments

8. Applicant's arguments filed August 04, 2000 have been fully considered, but the same are not persuasive.

Applicant argues:

a) Page 8, lines 24-25: "accesses a first storage medium storing.....". Applicant is referred to Ross et al, col 1, line, 57 and 52-53 and Fig. 6B.

b) Page 9, line 1: "media ID". Applicant is directed to Hasebe et al Fig. 2 (12).

c) Pages 10 through 11: " the predetermined key

.....
Thus use information represents a right to use the contents ". It's a matter of nomenclature, and license is nothing but means for a right to use information. As regard medium ID, applicant will appreciate that Hasebe et al clearly recite medium number (col 4, lines 10-11). Using a simple key, applicant has not claimed the same.

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In the light of above stated facts , Examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive and the rejections under prior Office Action, Paper No. 4, mailed April 26, 2000 are maintained.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

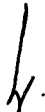
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is (703) 308-6683. The examiner can normally be reached on M-F from 11:00 am to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax numbers for the organization are (703) 305-0040/308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.


M. Irshadullah

November 17, 2000



ERIC W. STAMBER
PRIMARY EXAMINER